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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,313	06/28/2000	Brad Baker	30687-US	6871

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EXAMINER

TRAN LIEN, THUY

ART UNIT	PAPER NUMBER
1761	22

DATE MAILED: 08/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/607,313	Applicant(s) Baker
Examiner Lien Tran	Art Unit 1761



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on May 30, 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 29 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 29 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 21

6) Other:

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1. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over the brochure on “Paint Pop” in view of Kern and Gramlich for the same reason set forth in paragraph 1 of the previous office action.

2. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 29 recites the limitation “a paint brush holder attached to said container”; this limitation is not supported by the original disclosure and the drawings. The drawings do not show a paint brush holder attached to the container. The paint brush is attached to the container by packaging; page 11 of the specification discloses “the brush and can are connectable through packaging such as shrink-wrap, adhesive or other packaging”. There is no disclosure or showing of a separate “paint brush holder attached to the container”.

3. In the response filed May 30, 2002, applicant argues it is evident that shape of a product may affect function and distinguish prior art. Applicant has not set forth how the different shapes in the instant case affect function. Whether the candy is in the shape of a paint brush or the shape of a paint roll, it still has the same function of being the edible portion of the product. Applicant’s example of the airplane wing airfoil shape is not applicable to the instant case because candy is not comparable to airplane. Applicant argues the mere fact that both products are candy simulations of actual products used in house painting does not establish that the claimed subject matter is

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obvious except by use of pure hindsight. Hindsight is applicable when applicant's disclosure is used as the basis for the rejection and this is not the situation in the instant case. One of skill in the art is readily aware that both paint can/brush and paint tray/roller are conventional shapes and the adaptation of the candy to either conventional shapes would have been an obvious variation; this is a variation in design choice with no alteration in function. There are many lollipop products which come in many shapes and designs. Applicant's argument would have been persuasive if there is no teaching of any lollipop product which simulates actual paint product; in the instant case, the paint pop product is a teaching of a candy product which simulates actual paint product. The question is whether or not it would have been obvious to move from one conventional paint product shape to another conventional shape and the answer is yes because both paint can/brush and paint tray/roller are well known shapes for paint products. The substitution of one shape for another depends on the design desired and would have been obvious to one skilled in the art. Applicant further argues no lid is shown in the Paint Pop product. The picture of the Paint Pop product does not show a lid; however, it is inherent that the Paint Pop product has a shrinkage wrapping on the tray to prevent the roller and packet from falling out and this is equivalent to a lid. However, since the picture is not clear in this aspect, additional references were used to show the obvious reason for adding a lid. Applicant argues the utility of the lid in the claimed combination is that the powder may be contained in the lid-enclosed container at the time of sale and there is no suggestion in the Paint Pop product for the addition of a lid. Of course there is suggestion in the Paint Pop product for the addition of a lid because the

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powder in the Paint Pop product is also contained in the tray at the time of sale. If a lid is not included , not only will the powder falls out but the roller will also fall out. Additional, the lid will enable one to save the content if it is used at once, prevent the content from drying out and prevent spilling. Thus, there are ample reasons to include a lid in the Paint Pop product. Applicant argues the powdered candy is contained in a separate packet at the time of sale. Even though the powder is contained in a separate packet, it is also contained in the tray because the packet is in the tray. The picture of the Paint Pop product clearly shows a tray containing the roller and the powdered packet. Applicant contends it is both cheaper and more hygienic to sell the product with the flowable confectionery contained in a can with a removable lid than it is to place the flowable confectionery in a separate packet which must be ripped open and poured into the paint tray. Applicant has not shown that it is cheaper for the flowable confectionery to be contained in a can with a removable lid and why would it not be more hygienic or as equally hygienic when the powder is contained in a packet? Applicant does not offer any explanation for this statement. Lastly, applicant argues there is no disclosure of a holder for a paint brush which is attached to the container. The tray has a depression is which the roller is placed as shown in the picture; this is equivalent to the holder because it is not known what the claimed holder is. There is no disclosure of a separate holder or a showing of a separate holder in the specification. The specification discloses the brush and can are connected through packaging.

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In the response, applicant points to the declarations as secondary considerations showing commercial success and industry recognition. The declarations are not found to be persuasive for the following reasons.

With respect to Mr. Baker declaration, it is not found persuasive to demonstrate commercial success. The declaration states in about 3 years the marketed sales of the Paint Shop product have been in excess of 50 million. A sale figure does not demonstrate commercial success. The sale of a product is influenced by many factors such as the economy, populational growth, advertisement, marketing strategies etc... There is no evidence showing that the sale is resulting solely from the product. Also, it is not known what this sale figure means. The declaration also states the Paint Shop product received an award in 1999. How does this award relate to commercial success? There is no showing of connection between the award and commercial success. The declaration that Paint Shop is a highly successful product. This statement is an opinion and is not backed up by any evidence. In sum, there is no evidence in the declaration to show commercial success.

With respect to Mr. Moskowitz's declaration, it is not found to be persuasive. The declaration states the Roller Pop product was awkward to lick because the plastic handle was in the way; by contrast the paint brush candy sucker in the Paint Shop product can be easily licked on a side and access to the candy is not impeded by the plastic brush handle. This statement is not backed up by evidence. Were the two products tested on different populations to arrive at this conclusion. If the Roller Pop is awkward to lick because of the handle, the same problem would

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be encountered in the Paint Shop product because it also has a plastic handle. Access to the candy in the Roller Pop product is not impeded by the handle because the handle is only on one end of the candy. If one wants to lick all the sides of the candy, it is only necessary to change the orientation of the candy part. The declaration states that if the powder is not consumed, it could easily be spilled from the tray. This problem is the motivation for why it would have been obvious to add a lid to the Paint Pop product. The declaration also states that in several instances and also due to manufacturing difficulties, once the painter roller sucker was licked, it would then not roll properly or at all. It is not known what is covered under the phrase "several instances" but it is apparent that the problem stated does not occur all the time. It is not known what happened in those instances to cause the sucker not to roll properly. There is no evidence presented to show that the problem is due to the structure of the product. With respect to the statement about being consumed in one eating event, such problem is also the motivation for adding a lid to the Paint Pop product as suggested by the actual paint product references. The declarant states that it never occurred to him to put a lid on the Paint Pop product. The basis of the 103 rejection is what would have been obvious to one skilled in the art at the time of the invention. Knowing the problem of spilling, drying out etc. and with the teaching of a lid to cover a tray to prevent spilling and drying out and to enable to be used again after a time, it would have been obvious to one skilled in the art to put a lid on the Paint Pop product. Even without the teaching of a lid, it would have been obvious to use common sense to cover the tray with a covering or a piece of plastic if the powder is not all consumed and one wants to consume it again at a later time.

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With respect to Mr. Taylor declaration, there is no showing of evidence to demonstrate commercial success. The sale figures by themselves are not evident of commercial success because as stated above the sale of the product is based on many factors. In order to show commercial success, applicant needs to show that the success results solely because of the product and nothing else. The declaration states LolliPop Paint Shop outsold many other candies. The statement alone is not evidence of commercial success. It is not known if other factors such as marketing strategies, advertisement, populational changes, economy etc. are involved. Mr. Taylor states the success of a candy product is evidenced by the extent of distribution through various classes of trade. Many places of distribution of the product does not mean commercial success. There is no link between extent of distribution and commercial success. The extend of distribution might be part of the marketing strategy for the product. In fact, the extent of distribution might contribute to the reason why the Paint Shop outsold other candies. In which case, this is not evidence of commercial success because the sale is not due solely to the product but due to the way the product is marketed.

4. Applicant's arguments filed May 30, 2002 have been fully considered but they are not persuasive.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien Tran whose telephone number is 703-308-1868. The examiner can normally be reached on Wed-Fri. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

August 2, 2002


LIEN TRAN
PRIMARY EXAMINER
Group 1702